

REMARKS

The Office Action dated August 28, 2007, has been received and carefully noted. The above amendments to the claims, and the following remarks, are submitted as a full and complete response thereto.

Claims 1, 3, 17, 19-22, 24, and 26-30 are currently pending in the application, of which claim 1 is an independent claim. Claims 1, 3, 17, 19-22, 24, and 26-30 are respectfully submitted for consideration.

Claims 1, 3, 17, 19-22, 24, and 26-30 were rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The Office Action took the position that the claimed subject matter was not described in the specification in such a way as to reasonably convey to one of ordinary skill in the art that the inventor had possession of the invention. Specifically, the Office Action stated that there was not "adequate support in the disclosure, as originally filed, for the description of the movable electrode as being arranged as a 'torsion beam,' as now recited in claim 1, line 6." Applicant respectfully traverses this rejection.

It is puzzling that the Office Action has **again** rejected the claims based on the terminology "torsion beam," since it was the Examiner who suggested such terminology. Furthermore, as the Examiner himself had admitted by telephone, Figures 1, 2, 3, 4, 6, 7, 8, 9, 10, and 11, as originally filed, each fully support the recitation of the of the movable electrode being arranged as a torsion beam.

The term "torsion beam" is not found in the text of the specification. Nevertheless, a patent applicant is not in any way limited to the words found in the

specification. Section 112 of the Patent Act states that the “specification shall contain a written description of the invention.” 35 U.S.C. §112. The Federal Circuit has held that “[t]o fulfill the written description requirement, the patent specification must describe an invention in sufficient detail that one skilled in the art can clearly conclude that the inventor invented what is claimed.” *Cordis Corp. v. Medtronic AVE, Inc.*, 339 F.3d 1352, 1364, 67 USPQ2d 1876, 1885 (Fed. Cir. 2003). The Federal Circuit has explained, however, that “[t]he disclosure as originally filed does not ... have to provide *in haec verba* support for the claimed subject matter at issue.” *Id.* See additionally, *Kao Corp. v. Unilever United States, Inc.*, 78 USPQ2d 1257, 1260 (Fed. Cir. March 21, 2006). In other words, there is no requirement that the precise language used in the claims appear in the specification, in order to satisfy the written description requirement.

The concept claimed is fully supported in the specification, and especially in the figures, in such a way that one of ordinary skill in the art could clearly conclude that the inventor possessed the invention that is presently claimed. Therefore, the claims fully comply with the written description requirement. It is consequently respectfully requested that the written description rejection be withdrawn.

At page pages 6-7, item 6, the Office Action responded to the items listed above. The Office Action asserted that “the record fails to support either that the examiner suggested such terminology or that the examiner agreed to such a conclusion.” Of course, whether or not the record is complete with respect to everything the Examiner stated is moot. The concept of “torsion beam” is fully enabled by the specification as

originally filed, and the originally filed specification shows possession of the concept of a torsion beam arrangement.

Furthermore, the Office Action asserted that: “What the examiner did agree is that applicant’s device “appears to have a rotational arrangement similar to Fig. 1A of Mahon while Andersson appears to have a cantilever arrangement similar to Fig. 1B of Mahon.” This assertion, however, reinforces the points raised above, because it is consistent with the fact that the Examiner proposed the term “torsion beam” (even though the Examiner did not include that proposal in the interview summary) and with the fact that the concept of a “torsion beam arrangement” is a reasonable description of the embodiments illustrated in various figures of the present application.

Furthermore, the Office Action admitted that “Mahon describes the arrangement of Fig. 1 [of Mahon] as comprising ‘torsion beam members 400.’” This conclusively demonstrates that the description of the “similar” (quoting the Examiner) arrangements illustrated in the present application may also fairly be described by the term “torsion beam.”

The Office Action, however, asserted that despite the fact that Mahon describes the “similar” (with respect to torsion vs. cantilever arrangement) figure with term “torsion beam,” nevertheless (according to the Office Action) this “does not entitle the applicant to so describe his invention.” This is plainly incorrect. Patent applicants are entitled by Federal Circuit law to describe their invention as they see fit. It is reversible error for the Examiner to deny any patent applicant that right.

The Office Action also asserted that “To the extent applicant believe that the use of the terminology “torsion beam” is fully supported by the disclosure as originally filed, applicant should provide evidence that one of ordinary skill in the art would have from applicant’s disclosure that the movable electrode 5 rotates about the axis of rotation 7 formed by torsion beam members.” Of course, such evidence is already provided above by the analogy to Mahon. Furthermore, the Office Action has not disputed that “the movable electrode 5 rotates about the axis of rotation 7 formed by torsion beam members,” and consequently, the patent applicant here is not under any duty to positively prove what the Examiner has not disputed. After all, the burden is on the Examiner to make a case against patentability, and when the allegation is lack of possession, that burden is rather great. In this case, the burden clearly has not been met, and consequently the rejection should be withdrawn. Timely withdrawal is respectfully requested.

Claims 1, 3, 17, 19-22, 24, and 26-30 were rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,829,937 of Mahon (“Mahon II”) in view of U.S. Patent No. 5,723,790 of Andersson (“Andersson”) (a similar previous rejection had also cited over U.S. Patent No. 6,862,795 of Mahon (“Mahon I”)). This rejection is clearly improper, because Mahon II cannot be cited as prior art to show obviousness of the claims of the present application.

As previously explained in the response filed August 16, 2007, Mahon I and Mahon II cannot be used to show obviousness of the claims of the present application, because 35 U.S.C. 103(c) specifically prohibits the U.S.P.T.O. from putting the references to such use. 35 U.S.C. 103(c) specifically indicates that if a reference is only

available as prior art under subsection (e) of 35 U.S.C. 102, and if the reference was subject to an obligation of assignment to the same entity as the application under examination, then the reference cannot be used to establish obviousness of the claims of the application under examination. Mahon I and II meet both those qualifications, and consequently the Office Action's usage of the references is clearly contrary to U.S. law.

Mahon I and II were each issued after the filing date of the present application. The present application was filed February 10, 2004, but Mahon I issued March 8, 2005, and Mahon II issued December 14, 2004. Accordingly, the only subsection of 35 U.S.C. 102, under which either Mahon I or Mahon II could possibly qualify as prior art is under subsection (e). Thus, both Mahon I and II meet the first aspect in qualifying as a prohibited reference under 35 U.S.C. 103(c).

Likewise, both Mahon I and II were under an obligation of assignment to the same entity as the present application. Mahon I's assignee is listed on the cover of the patent as "VTY Holding Oy," but this identification contains a typographic error, which is shown on the certificate of correction, which corrects the error, such that the listed assignee is "VTI Holding Oy." Similarly, Mahon II lists "VTI Holding Oy" as its assignee. It should be clear that Mahon I and II were both the invention of Mr. Geoffrey L. Mahon, and, thus, the clear assignment of Mahon II provides evidence that the typographically incorrect assignment of Mahon I was due to an unintentional error.

The present application was under an obligation of assignment to the same entity as Mahon I and II. Evidence of this mutual obligation of assignment is seen, for example, on the cover of the priority document, which lists "VTI Technologies Oy" as

the applicant, by the original assignment filed together with the response to notice to file missing parts in the present application on July 6, 2004, which lists "VTI Technologies Oy" as the assignee (which was recorded the same day at Reel 015546, Frame 0567), by the fact that both Mahon I and Mahon II were assigned to VTI Holding Oy in 2002, and the fact that (although the precise address differs slightly between Mahon I and II and that of the present application) the same country, city, and even street is in common. Furthermore, additional evidence was provided in a previous response mailed August 25, 2006, which is already of record in the file wrapper of the present application. Thus, it is clear that Mahon I and II also each meet the second requirement for prohibited usage under 35 U.S.C. 103(c).

Accordingly, as has been shown above, neither Mahon I nor Mahon II may be legally used to show obviousness of the claims of the present application.

In the response to arguments section, the Office Action asserted that this rejection has not been overcome, because although sufficient evidence has been presented to invalidate the use of Mahon I, there has not been sufficient evidence presented to invalidate the use of Mahon II. It seems that the Office Action has in essence requested that Applicant's representative specifically state that Mahon II was subject to an assignment (or obligation of assignment) to the same entity as the present application at the time the present invention was made. Applicant has already provided documentation in support of such an assertion. If the rejection has been properly understood, then Applicant respectfully submits that Mahon II was subject to an assignment (or obligation

of assignment) to the same entity as the present application at the time the present invention was made.

Also, Applicant respectfully points out that the mutual obligation of assignment is evidenced by an earlier date than the filing date of the present application, namely by the cover of the priority document filed with the present application. The priority document names as the applicant: "VTI Technologies OY." Furthermore, the invention has been made after that date, namely after the date of August 9, 2002, on which both Mahon I and Mahon II were assigned to the assignee of the present invention. On October 31, 2002, the assignee's name changed from "VTI Holding Oy" to "VTI Technologies Oy," with the former name being retained as a subname. Thus, it is fully correct to state that "Mahon II was subject to an assignment (or obligation of assignment) to the same entity as the present application at the time the present invention was made." Timely withdrawal of the rejection is respectfully requested.

Additionally, claims 1, 3, 17, 19-22, 24, and 26-30 were rejected on the grounds of non-statutory obviousness-type double-patenting as being unpatentable over claim 28 of Mahon II in view of Andersson. This type of rejection may be overcome by filing a terminal disclaimer. A properly executed terminal disclaimer is enclosed herewith. Withdrawal of the double-patenting rejection is respectfully requested in view of the terminal disclaimer.

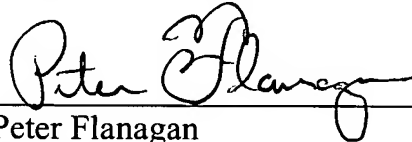
For the reasons set forth above, it is respectfully submitted that each of claims 1, 3, 17, 19-22, 24, and 26-30 recites subject matter that is neither disclosed nor suggested in

the cited art. It is, therefore, respectfully requested that all of claims 1, 3, 17, 19-22, 24, and 26-30 be allowed, and that this application be passed to issuance.

If for any reason the Examiner determines that the application is not now in condition for allowance, it is respectfully requested that the Examiner contact, by telephone, the applicant's undersigned representative at the indicated telephone number to arrange for an interview to expedite the disposition of this application.

In the event this paper is not being timely filed, the applicant respectfully petitions for an appropriate extension of time. Any fees for such an extension together with any additional fees may be charged to Counsel's Deposit Account 50-2222.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Peter Flanagan", is written over a horizontal line.

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Enclosures: Submission of Terminal Disclaimer with Terminal Disclaimer
Petition for Extension of Time
Check No. 017679